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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,851	12/20/1999	BRUCE A. LEAK	MS-137856.1	2863

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EXAMINER

TRAN, HAI V

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/467,851	Applicant(s) LEAK ET AL.	
	Examiner Hai Tran	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1,4-22,25 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,23,24,26-37 and 39-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/28/2006 has been entered.

Response to Arguments

Applicant's arguments, filed 04/28/2006, with respect to claims 2-3, 23-24, 26-35, 36-37, 39-54 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the copending Application No. **10/893518**.

Claim Objections

Claims 40-41 are objected to because of the following informalities: limitation "A method as recited" in line 1 of claims 40 and 41 should be "A system as recited". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 33 of copending Application No. **10/893518**. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application claim 23 and copending Application claim 33 are both drawn to the same invention, in which receivers are configured to be either connected or disconnected receiver and both type of receivers are able to receive both connected/disconnected-content triggers and based on their configurations to execute the received trigger accordingly to their configurations for retrieving corresponding content. These claims differ in scope in that application claim 23 is narrower in scope than copending Application claim 33. It would have been obvious to one of ordinary skill in the art to modify claim 23 of the copending Application in order to obtain claim 33 of the instant application.

Claim 36 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 23 of copending Application No.

10/893518 . Although the conflicting claims are not identical, they are not patentably distinct from each other because Application claim 36 and copending Application claim 23 are both drawn to the same invention, in which receivers are configured to be either connected or disconnected receiver and both type of receivers are able to receive both connected/disconnected-content triggers and based on their configurations to execute the received trigger accordingly to their configurations for retrieving corresponding content. These claims differ in scope in that application claim 36 is narrower in scope than copending Application claim 23. It would have been obvious to one of ordinary skill in the art to modify claim 23 of the copending Application in order to obtain claim 36 of the instant application.

Claims 42 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 41 of copending Application No.

10/893518 . Although the conflicting claims are not identical, they are not patentably distinct from each other because Application claim 42 and copending Application claim 41 are both drawn to the same invention, in which a computer program product implemented on receivers for configuring the receivers to be either connected or disconnected receiver and both type of receivers are able to receive both connected/disconnected-content triggers and based on their configurations to execute

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the received trigger accordingly to their configurations for retrieving corresponding content. These claims differ in scope in that application claim 42 is a computer program product and is narrower in scope than copending Application method of claim 41. It would have been obvious to one of ordinary skill in the art to modify claim 41 of the copending Application in order to obtain claim 42 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

If Applicant agrees that there exists a provisional Obviousness type of Double patenting between the Application No 09/467,851 and Co-pending Application 10/893518, and since there exists terminal disclaimers between the instant application with Patent 6,668,378 and 6,460,180, and a terminal disclaimer between Patent 6,668,378 and Patent 6,460,180, the Examiner requests applicant to provide

- a terminal disclaimer between the instant application and the Co-pending Application 10/893518, and
- a terminal disclaimer between the Co-pending Application 10/893518 and each of the Patent 6,668,378 and 6,460,180.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305.

The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht
06/23/2006



HAITRAN
PRIMARY EXAMINER